



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,646	02/21/2001	Stacy Rhea Steuart	52493.000127	7075

7590 07/21/2009
Jennifer A. Albert, Esq.
Hunton & Williams
Suite 1200
1900 K Street, N.W.
Washington, DC 20006

EXAMINER

ADE, OGER GARCIA

ART UNIT	PAPER NUMBER
----------	--------------

3687

MAIL DATE	DELIVERY MODE
-----------	---------------

07/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/788,646	Applicant(s) STEUART ET AL.	
	Examiner GARCIA ADE	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,8,12-14,16,21-24,28-30,35 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,8,12-14,16,21-24,28-30,35 and 53-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/25/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on **02.06.2009** has been considered. Applicants amended **claim 14** and added new **claims 56-58**.
2. The Examiner withdraws the Allowable Subject Matter of **claims 54 and 55** because of the 101 and 112 second paragraph rejections (see below).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 54 and 56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the key limitations in the claim, for example in claim 1: “generating the sales-related data, at the supplier, based on the received request-related information and based on the state related information”, in claim 54: “transmitting an email to a second email address of the broker if the user’s state of residence selection does not correspond to a state in which the broker is licensed to do business”, and in claim 56: “means for transmitting an email to a second email address of the broker if the user’s state of residence selection does not correspond to a state in which the broker is licensed to do business” are not tied to an apparatus or a machine.

Examiner suggests including some type of machine or apparatus in the key limitations.

Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the above claims fails to meet the above requirements because the steps are neither tied to a particular machine or apparatus nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. See also, United State Court of Appeals for the Federal Circuit, 2007-1130, (Serial No. 08/833,892) IN RE BERNARD L. BILSKI and RAND A. WARSAW.

In claims 1, 54 and 56, the steps do not recite any particular machine or apparatus, and it can be concluded, under a broad interpretation, that those steps were manually performed. Here, to be statutory, under USC 101, each individual step should incorporate or should be performed using a particular machine (computer, apparatus or hardware per se).

Dependent **claims 2-3, 7, 8, 12-14, 16, 57 and 58**, do not correct the above deficiencies and are, likewise, rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 21-24, 28-30, 35, and 55** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph, for example in **claims 21 and 55** by using the phrase “means for” language, such as “means for accessing at least one web page ...”, “means for receiving, at the supplier, a request for sales-related data .. ”.

The Phrase “Means for” Is Used, but Unclear Whether the Recited Structure, Material, or Acts in the Claim Are Sufficient for Performing the Claimed Function.

In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function or step-plus-function language; (2) the claim itself must not provide structural limitations to the means-plus-function, or step-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function, or step-plus-function

Art Unit: 3687

language in the claim. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong.

There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function or step-plus-function limitations in the claim. The only "structure" for performing the functions in the above claims appears to be computer program modules (i.e. virtual structure, not physical structure). Therefore, 35 U.S.C. 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means or steps to perform the claimed functions as any means or steps, physical or virtual, which can perform the function.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for").

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

Art Unit: 3687

subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-3, 7, 8, 12-14, 16, 21-24, 28-30, 35, 53-58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. in view of Hanby et al.

As per claims 1, 6, 16, 21, 23, 24, and 54-56, Bennett discloses a dedicated terminal 1003 at which data is exchanged. As such, it discloses providing sales-related data over a network (***SHIPPING OR BUY/BIDDING***), the sales related data being transmitted from a supplier (***iShip***) to a broker (***shipper PC 1003***) and being customized for the broker (user enters provider's system through a hypertext e-mail link), accessing at least one web page of a broker by inputting a broker network address (read as: ***Each Shipper, using a client computer device, accesses the System over a global communications network such as the Internet***); receiving at a supplier a request for sales-related data from a user associated with a broker (***user uses the computer of the broker to get nearest shipping location based on e mail address***), the request for sales related data input from a broker network address being utilized for the transmission of the request for sales related data (see, column 20, line 42, ***shipping center data defaults to preset origin zip code locations based on e-mail address recognized at log on***); accessing broker information of the supplier, using the broker network address to retrieve broker information from a broker information database (***ship center database is accessed for shipping location***); displaying to the user at least a portion of the broker information with at least a portion of related information (***system displays the location of nearest***

Art Unit: 3687

shipping location, column 20); receiving at the supplier request-related information from the user (***user sends weight of package information to system***).

But Bennett does not explicitly disclose insurance based inquiry system and thus does not explicitly disclose accessing state related information that includes at least one of the users' state of residence and the state in which the broker is licensed and generating the sales-related data based on the received request-related information based on the state related information, and including broker contact information.

However, Hanby discloses an internet based insurance sales method/system wherein the quote engine the require rule to effect the desired quote see, column 6 line 35; ***including broker contact information*** at column 4, and official notice is taken of the state based rate for insurance policies. It would be obvious to modify Bennet to include the internet based insurance purchasing application taught by Hanby et al. the motivation being the rapidity of ordering before rate changes occur. The article claims of 21 et seq. are deemed met by the function described above in terms of the apparatus, which performs the same.

Regarding claims 2, 3, and 22, Bennett discloses asking the user to select the user's state of residence; and receiving the user's state of residence selection, and the user's zip code caused the closest most location to be displayed thereby answering wherein the step of generating the sales-related data includes the sub-step of determining the sales-related data to generate based on the user's state of residence selection.

Regarding claims 7, 8, and 57, Bennett discloses the step of receiving the request-related information from the user includes receiving at least one of a date of birth, a state of residence, a height, a weight, a gender, a type of product desired, and a county of citizenship original zip code, which answers to receiving a state of residence, also illustrated in figure 17 (e.g. ***the System requests the User to provide the necessary information by completing the information requested in subsequent screens 150-1. If the User clicks the Next button 102, the System displays the Seller's Carrier/Service Preferences Screen 49, and the Seller's Charges and Payment Preferences Screen 50 as depicted in FIG. 10b***), and the freight charge is read as sales-related duty.

Regarding claims 12-14, 28-30, 35, 53, and 58, official notice is taken of the old and notorious practice of generating an error message, returning incomplete forms and generating a decline message for unacceptable responses.

Response to Arguments

9. Applicants' arguments filed on **02.06.2009** have been fully considered but they are not persuasive, and have been addressed in the above rejection.

Applicant's attempt at traversing the Official Notice findings as stated in the April 10, 2006 Office Action is inadequate. Adequate traversal is a two step process. First, Applicant must state their traversal on the record. Second, and in accordance with 37 C.F.R. § 1.111(b) which requires Applicant to specifically point out the supposed errors

Art Unit: 3687

in the Office Action, Applicant must state why the Office Action statements are not to be considered common knowledge or well known in the art.

In this application, Applicant has clearly met step (1) as traversal of Official Notice has been taken. Second, Applicant has failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. Applicant did not affirmatively state why such common knowledge is not known. Because Applicant's traversal is inadequate, the Official Notice, e.g. common knowledge, statements are taken to be admitted as prior art. See, MPEP § 2144.03.

The proposed combination of Bennett-Hanby is analogous because they are all concerned with inventory management system. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. It is necessary to consider the reality of the circumstances, in other words, common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. In re Wood, 599 F.2d 1032, 1036, (C.C.P.A. 1979).

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the references are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. It is necessary to consider the reality of the circumstances, in other words, common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. In re Wood, 599 F.2d 1032, 1036, (C.C.P.A. 1979). A reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as basis of rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately. The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

For the above reasons, it is believed that the rejections should be sustained. Therefore, Applicants arguments are deemed nonpersuasive.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The PTO 1449 forms have been reviewed and considered.

Art Unit: 3687

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARCIA ADE whose telephone number is (571)272-5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3687

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art Unit 3687

Garcia Ade
Examiner
Art Unit 3687

ga